

VIA FACSIMILE ONLY

Patent
Attorney Docket No. 4389

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
APPEAL NO. 2009-5706**

Appellant:	Brian E. Dalton)	
)	
Application No.:	10/642,976)	Swiger III, James L.
)	Patent Examiner
Filed:	August 18, 2003)	Art Unit 3733
)	
For:	CERVICAL COMPRESSION PLATE)	
	ASSEMBLY)	
			Pittsburgh, Pennsylvania

Board of Patent Appeals and Interferences
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sirs:

Applicant received a Docketing Notice from the Board of Patent Appeals and Interferences mailed March 20, 2009. A copy of the Docketing Notice is enclosed.

The Docking Notice indicates that no reply to the Brief was filed. However, this is not the case.

Applicant filed a REPLY TO EXAMINER'S ANSWER on June 17, 2008, the same has been considered by the Examiner and was forwarded to the Board. A copy of the REPLY TO EXAMINER'S ANSWER and the Examiner's Notice is attached.

Accordingly, kindly also consider Applicant's REPLY TO EXAMINER'S ANSWER.

Respectfully submitted,

CAROTHERS AND CAROTHERS



Floyd B. Carothers
Attorney for Brian E. Dalton
Fort Pitt Commons, Suite 200
445 Fort Pitt Boulevard
Pittsburgh, PA 15219

FBC:jkc
Reg. No. 24,252
(412) 471-3575
(412) 471-3597 Fax
Pittpatent@aol.com

Best Available Copy



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,976	08/18/2003	Brian E. Dalton	4389	3409

7590 03/20/2009
Floyd B. Carothers
CAROTHERS AND CAROTHERS
Suite 200
445 Fort Pitt Blvd.
Pittsburgh, PA 15219

EXAMINER

SWIGER III, JAMES L.

ART UNIT

PAPER NUMBER

3775

MAIL DATE

DELIVERY MODE

03/20/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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**Under Secretary of Commerce for Intellectual Property and
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**FLOYD B. CAROTHERS
CAROTHERS AND CAROTHERS
SUITE 200
445 FORT PITT BLVD.
PITTSBURGH, PA 15219**

**Appeal No: 2009-5706
Application: 10/642,976
Appellant: Brian E. Dalton**

Board of Patent Appeals and Interferences Docketing Notice

Application 10/642,976 was received from the Technology Center at the Board on December 16, 2008 and has been assigned Appeal No: 2009-5706.

A review of the file indicates that the following documents have been filed by appellant:

Appeal Brief filed on:	January 28, 2008
Reply Brief filed on:	NONE
Request for Hearing filed on:	NONE

In all future communications regarding this appeal, please include both the application number and the appeal number.

The mailing address for the Board is:

**BOARD OF PATENT APPEALS AND INTERFERENCES
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VIRGINIA 22313-1450**

The facsimile number of the Board is 571-273-0052. Because of the heightened security in the Washington D.C. area, facsimile communications are recommended. Telephone inquiries can be made by calling 571-272-9797 and should be directed to a Program and Resource Administrator.

By order of the Board of Patent Appeals and Interferences



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/642,976

08/18/2003

Brian E. Dalton

4389

3409

7590 07/24/2008
CAROTHERS AND CAROTHERS
Suite 500
445 Fort Pitt Blvd.
Pittsburgh, PA 15219

EXAMINER

SWIGER III, JAMES L

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
10642976	8/18/2003	DALTON, BRIAN E.	4389

CAROTHERS AND CAROTHERS

Suite 500

445 Fort Pitt Blvd.

Pittsburgh, PA 15219

EXAMINER

JAMES L. SWIGER III

ART UNIT

PAPER

3733

20080721

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

The REPLY TO EXAMINER'S ANSWER filed on 6/17/2008 has been considered and is being forwarded to the Board of Patent Appeals and Interferences.

/Eduardo C. Robert/
Supervisory Patent Examiner, Art Unit 3733

/JAMES L SWIGER/
Examiner, Art Unit 3733

Patent

Attorney Docket No. 4389

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant: Brian E. Dalton)

Application No.: 10/642,976)

Filed: August 18, 2003)

For: CERVICAL COMPRESSION PLATE)
ASSEMBLY)Swiger III, James L.
Patent Examiner
Art Unit 3733

Pittsburgh, Pennsylvania

REPLY TO EXAMINER'S ANSWER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Examiner's Answer requires a response in regard to the Examiner's arguments set forth under Section (10) Response to Argument. Appellant therefore replies as follows:

(10) RESPONSE TO ARGUMENT

The Examiner states that "The functional limitation of being 'configured to' is similar to 'capable of' where it has been held at the recitation that an element is 'capable of' performing a function is not a possible limitation but only requires the ability to so perform and further does not constitute a limitation in any patentable sense." In this regard the Examiner cites *In re Hutchison*, 69 USPQ 138.

This analysis made by the Examiner is completely inaccurate. The limitation "configured to" specifically means that the device so configured must have the required dimensions and contours to carry out the required function. To the contrary, the term "capable of" implies no such physical limitations and therefore the Examiner's analysis does not follow. The term "configured to" cannot be considered equal to the term "capable of". It is respectfully submitted that while the term "capable of" is not a positive limitation, that nevertheless, the term "configured to" is in fact a positive limitation. Therefore, the ruling of *In re Hutchison* does not apply.

In conclusion, the references or any combination thereof do not suggest Applicant's invention as claimed, and the Examiner's rejection should be overturned.

Respectfully submitted,

CAROTHERS AND CAROTHERS

Floyd B. Carothers
Attorney for Brian E. Dalton
Fort Pitt Commons, Suite 200
445 Fort Pitt Boulevard
Pittsburgh, PA 15219

FBC:jkc
Reg. No. 24,252
(412) 471-3575
(412) 471-3597 Fax
Pittpatent@aol.com

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on June 12, 2008

CAROTHERS AND CAROTHERS

Floyd B. Carothers

Carothers and Carothers

Fort Pitt Commons, Suite 200
445 Fort Pitt Boulevard
Pittsburgh, PA 15219

Business Phone: 412-471-3575
Fax: 412-471-3597
Email Address: Pittpatent@aol.com

FAX COVER SHEET

DATE: April 10, 2009

TO: Board of Patent Appeals and Interferences

FAX PHONE: (571) 273-0052

FROM: Floyd B. Carothers

SUBJECT: Appeal No. 2009-5706

PAGES: 9 (including cover sheet)

DOCUMENTS	NUMBER OF PAGES*

COMMENTS:

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